

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

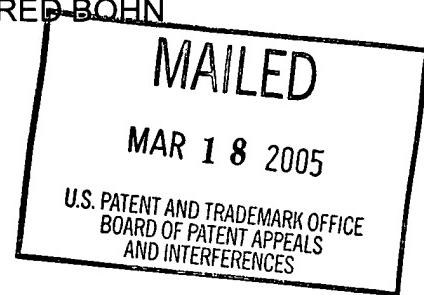
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte KARL T. KRAEMER AND MANFRED BOHN

Appeal No. 2005-0122
Application No. 09/425,742

ON BRIEF



Before WILLIAM F. SMITH, MILLS and GREEN, Administrative Patent Judges.

MILLS, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our consideration of the record leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the examiner to consider the following issues and take appropriate action. This appeal under 35 U.S.C. §134 from the examiner's final rejection concerns claims 1-2, 4-8, 10-13, 16-17, 22-23, 28-29, which are all of the claims pending in this application.

Claim 1 is illustrative of the claims on appeal and appears in the Appendix to the Brief, attached.

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The prior art references relied upon by the examiner are:

Cretois	5,558,859	Sept. 24, 1996
Dubois	6,162,444	Dec. 19, 2000
Ismail	5,541,220	Jul. 30 1996
Lai	5,916,910	Jun. 29, 1999
Hocquaux et al ('317)	WO 92/21317	Dec. 10, 1992
Hocquaux et al. ('701)	WO 91/19701	Dec. 26, 1991

Grounds of Rejection

Claims 1-2, 4-8, 10-13, 16-17, 22-23, 28-29 stand rejected under 35 U.S.C. 103(a) for obviousness over Cretois in view of Dubois.

Claim 14 stands rejected under 35 U.S.C. 103(a) for obviousness over Cretois and Dubois in further view of Lai.

Claim 15 stands rejected under 35 U.S.C. 103(a) for obviousness over Cretois and Dubois in further view of Ismail.

Claim 19 stands rejected under 35 U.S.C. 103(a) for obviousness over Cretois and Dubois in further view of WO 92/21317.

Claim 21 stands rejected under 35 U.S.C. 103(a) for obviousness over Cretois and Dubois in further view of WO 91/19701.

We remand the application to the examiner for the following reasons.

DISCUSSION

1. Claim Interpretation

Claim 1 is essentially directed to

A composition comprising:

- a) at least one physiologically tolerated film-forming agent;
- b) at least one physiologically tolerated solvent;
- c) at least one plasticizer; and
- d) a compound of formula 1 (not reproduced here)

wherein said compound of formula 1 is released from the film formed by application of said composition to a skin surface.

The examiner argues that the limitation of the wherein clause is a property of the composition and its constituents. Answer, page 5. The examiner also states "the intended use of the composition claims, i.e. the recitation of 'application of said composition to a skin surface,' is not given patentable weight." Answer, page 8. We disagree with this characterization of appellants claims.

In our view the examiner was correct in the first instance when it was indicated that the wherein clause is a property of the composition and its constituents. We agree with appellants that this clause in the claim must be given patentable weight. The wherein clause is not simply an intended use for the claimed composition, it tells those of ordinary skill in the art something about the nature of the characteristics of the

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composition, limiting the claim to those compositions which release the compound of formula 1 from the film formed by application of said composition to a skin surface. In other words, appellants only claim a subset of compositions which release the compound of formula 1 from the film when applied to the skin.

In view of the claim interpretation above, the application is remanded to the examiner to evaluate the record and cited prior art, consistent with this interpretation.

It is recommended that the examiner also review the following matters.

2. 35 U.S.C. § 103

Claims 1-2, 4-8, 10-13, 16-17, 22-23, 28-29 stand rejected under 35 U.S.C. 103(a) for obviousness over Cretois in view of Dubois.

It is the examiner's position that (Answer, page 4):

Cretois teaches compositions for the treatment and protection of the exoskeletal parts, such as hair and skin, comprising in a cosmetically acceptable medium, at least one ceramide and/or glyceroceramide and at least one vinyl pyrrolidone polymer. Polyoxyethylenated carboxylic ether acids are disclosed as anionic surfactants that are added to the composition. Water and alcohols such as ethanol and isopropanol, and combinations thereof are disclosed as cosmetically acceptable mediums. Antiseborrhoeic agents are disclosed as additives. Exemplified is a hair care composition comprising Luviquat FC 905 (**plasticizer**, copolymer of vinylimidazolium methochloride and vinyl pyrrolidone) and Cremophor RH 410 (**film forming agent**, polyethoxylated hydrogenated castor oil). The reference lacks instant formula (I) and 5-alpha-reductase inhibitors.

However, appellants' specification, page 10, states that suitable **film-forming** agents include polyvinylpyrrolidine/imidazolium methochloride copolymers. Suitable

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plasticizers according to the specification "are chosen from polyoxyethylated castor oil, ethoxylated cholesterol, and panthenol." Specification, page 10. Thus, the examiner characterizes the copolymer of vinylimidazolium methochloride and vinyl pyrrolidone to be a **plasticizer**, whereas appellants' specification indicates this compound is a film-forming agent. Similarly, the examiner characterizes the castor oil as a film forming agent and appellants indicate in the specification that the castor oil is a plasticizer. The examiner and appellants characterize these compounds in an opposite manner.

Upon return of the application to the examiner, the examiner should clarify the nature of the above noted compounds, as appropriate. If necessary, the examiner should consider whether an appropriate objection/rejection to the specification is in order in view of this discrepancy.

3. We agree with the examiner that it would facially appear to have been obvious to use the antiseborrhoeic agent of Dubois in place of the anti-seborrhoeic agent described in Cretois. What the examiner has failed to determine due to the flawed claim interpretation noted above, is whether the liposomes and film-formers of the prior art would have released the compound of formula 1 upon application to the skin, as claimed.

For example, the examiner should determine whether the substitution of the anti-seborrhoeic agents of Dubois encapsulated in a liposome (which may be a sphingolipid) for the ceramides containing the anti-seborrhoeic agent in Cretois in the context of the

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plasticizers and film forming agents described in Cretois, can be done in a manner which allows the compound of formula 1 to be released from the film formed by application of said composition to a skin surface.

Appellants would appear to argue that this is not the case. Appellants argue at page 14 of the Brief that, "One of ordinary skill in the art, considering Cretois' disclosure, would understand that sphingolipids react or interact with the vinylpyrrolidone polymers to cause this shape-retaining effect, for example, by immobilizing the sphingolipid on the hair in a film formed with the vinylpyrrolidone polymer. Thus, the examiner should determine if the shape-retention compounds of Cretois upon substitution of the liposomes of Dubois would allow for release of the active agent when applied to the skin.

In addition, the examiner should determine whether the statements of appellants arguing that the sphingolipid would be immobilized on the hair, i.e. not release the active agent, is mere attorney argument or if appellants have provided evidence to support this position.

The examiner should also determine, if, in fact, appellants use the same film formers and plasticizers as Cretois, and whether there is an actual difference in how the compositions release active ingredient from the film. The examiner should make a finding whether the liposomes of Dubois would work when substituted for the ceramide of Cretois to release the active agent from the liposome vessel wall.

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CONCLUSION

The application is remanded to the examiner for reconsideration consistent with claim interpretation and the recommendations herein.

REMANDED

William F. Smith)
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Administrative Patent Judge)
)
Demetra J. Mills) BOARD OF PATENT
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Eric Grimes) APPEALS AND
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